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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,977	02/20/2004	Gregory J. Speicher	935-016	4391

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EXAMINER	
CHAMPAGNE, DONALD	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/783,977	SPEICHER, GREGORY J.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *23-32* is/are allowed.

6)☒ Claim(s) *33-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3 sheets*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 2 May 2006 have been fully considered but they are not entirely persuasive. The arguments are addressed at para. 7-10 below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 33-42 are rejected under 35 U.S.C. 103(a) as being anticipated by Witek et al. (US006253188B1) in view of Lubachevsky (US005764732A).

4. Witek et al. teaches (independent claims 33 and 38) a method for operating a computer based advertising system, wherein said method comprises the steps of: receiving from a advertiser/first party data via the Internet for a personals ad (col. 55 lines 59-60 and col. 12 lines 28-31), which inherently contains personal information that reads on a "personal profile"; a respondent/second party leaving a voicemail message for said first party via a telephone and said first party retrieving said voicemail message via a telephone (col. 2 lines 26-30). Witek et al. also teaches receiving the Internet address to which search results are to be sent (col. 21 lines 13-17 and col. 27 line 7), which reads on receiving an email address from said advertiser/first party. Witek et al. expressly teaches email at col. 4 line 18.

5. Witek et al. does not teach sending an email to said first party that provides notification of a voicemail message for said first party. Lubachevsky teaches sending an email to a called party/first party, that provides notification of a voicemail message for said called/first party (col. 3 lines 19-24). Because Lubachevsky teaches that this enables the calling party to get verification that the message has been received (col. 1 lines 45-50), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Lubachevsky to those of Witek et al. and Irribarren.

6. None of the references teach (independent claim 8) reviewing and approving said audio recording prior to presentation to other users. Because this would prevent pornographic or other distasteful material from being disseminated, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add this limitation to the teachings of Witek et al. and Lubachevsky.

7. Applicant also argues (p. 13) that an "internet protocol address" is very different from an "email address". That depends on the interpretation of the claim term "email".

8. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

9. The instant application contains no such clear definition for the term "email". In the instant case, the examiner is required to give the term "item selection histories" its broadest reasonable interpretation, which the examiner judges to be any text message (Microsoft Press Computer Dictionary, 3rd ed.). The message requests and responses taught by Witek at al. (col. 6 lines 46-62) read an email, and the associated Internet addresses are therefore email addresses.

10. Applicant also argues (p. 15) that Lubachevsky teaches mailboxes established only for a specified duration. That is irrelevant because that is not the teaching referenced.

11. Witek et al. also teaches (claims 34 and 39) adding an image (col. 45 line 62), whose review and approval is obvious (para. 8 above) and (claims 35 and 40) executing a search (col. 20 lines 63 *et seq.*). Claims 36, 37, 41 and 42 are also taught at the citations given above.

Allowable Subject Matter

12. Claims 23-32 are allowed, subject to cancellation of the non-allowed claims, and successful completion of the "template" search and vetting by an allowance conference.

13. The following is an examiner's statement of reasons for allowance: The allowed claims differ only in obvious ways from US patent US005996006A by the inventors, and an acceptable terminal disclaimer has been filed.

14. The following is an examiner's statement of reasons for allowance: the closest prior art, Witek et al. in view of Lubachevsky, does not teach or suggest receiving a video recording. This applies to both independent claims 33 and 38. Irribarren (US005737395A) teaches an integrated voice and text message system where audio and video recordings can be added (col. 4 lines 53-60 and col. 15 line 65 to col. 16 line 2). However, the prior art does not suggest adding the teachings of Irribarren to those of Witek et al. and Lubachevsky. The examiner said otherwise in the last rejection (mailed on 2 November 2006, para. 13), but applicant's arguments on this point (filed 2 May 2006, pp. 14-15) are compelling. In essence, and Irribarren's implications to the contrary, the state of the art did not generally possess a good quality video capability at the time of the invention. Sterne, published shortly after the (November 1996) priority date of the instant application, suggests as much. It is also significant that the "webpersonal" website that was copied three months after applicant's priority date and made of record by applicant, used audio but not video.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

20. **The examiner will be pleased to consider applicant's request to put the application into condition for allowance by examiner's amendment.**

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov.

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

7 August 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER